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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/627,391 | 07/25/2003 | James B. Crews | 304-25098-USCQ | 3933 |
| 24923 | 7590 | 08/24/2005 | EXAMINER | |
| PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA, SUITE 700 HOUSTON, TX 77057-1130 | | | TUCKER, PHILIP C | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1712 | | |

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/627,391 | CREWS, JAMES B. | |
| | Examiner | Art Unit | |
| | Philip C. Tucker | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11, 14, 17-25, 28 and 31-40 is/are rejected.
- 7) Claim(s) 12, 13, 15, 16, 26, 27, 29 and 30 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 31-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 teaches "at least one metal in an amount effective to catalyze", but fails to teach what is being catalyzed, or the nature of the metals. Since almost any metal may act as a catalyst under various conditions, the scope of the claim is uncertain. The dependent claims fall herewith.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11, 14, 17-25, 28 and 31-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Card (5877127).

Card teaches a method of fracturing a subterranean formation in which an aqueous fluid gelled with a polysaccharide, and containing a polyol within the scope of the present invention is used (see the examples, Tables 1, 2 and 3 and column 11, lines

18-62). Metal ion compounds, such as cobalt and nickel hydroxides may be used therein (column 9, lines 17-35). Such nickel and cobalt compounds would inherently act as catalysts as in the present invention. With respect to claim 31, any metal taught in Card would anticipate, since what is being catalyzed, and the scope of the metal is not disclosed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4, 6-11, 14, 17, 18, 19, 21-25, 28, 31, 32 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms (5143157).

Harms teaches an aqueous fluid gelled with a polysaccharide wherein a gluconic acid and its salts, and a copper compound may be used as breakers (see column 2, lines 10-33. The composition may be used up to temperatures of about 140 degrees F (column 1, lines 57-60). The total concentration of Breaker would be within the scope of the present invention (column 4, lines 19-42). A compound which raises the pH of the composition, such as diethanolamine is taught in Example 1. Harms differs from the present invention in that a specific example utilizing gluconic acid or its salts and a copper compound is not disclosed. Harms however teaches that more than one compound selected from the group (c) may be used (see column 2, lines 21-22).

Furthermore, case law has held that employing two or more materials for the same purpose that they are individually taught as being useful is not patentable (In re Kerkhoven USPQ 205 1069). The utility of a copper compound, and gluconic acid or its salts in combination as a breaker would thus be obvious to one of ordinary skill in the art in view of the teaching of Harms that they are individually useful for such purpose.

7. Claims 12, 13, 15, 16, 26, 27, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3836